

**RECEIVED
CENTRAL FAX CENTER****APR 06 2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tipton, et al.

Attorney Docket No.: NOVLP075/NVLS-000820

Application No.: 10/672,311

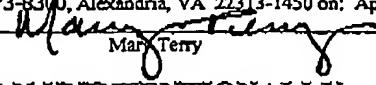
Examiner: COLEMAN, WILLIAM D

Filed: September 26, 2003

Group: 2823

Title: METHOD OF POROGEN REMOVAL
FROM POROUS LOW-K FILMS
USING UV RADIATION

CERTIFICATE OF FACSIMILE TRANSMISSION:

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office, Commissioner for Patents, Attn: Examiner Coleman, Fax No. (571) 273-8300, Alexandria, VA 22313-1450 on: April 6, 2007.
Signed: 
Mary Terry

**RESUBMITTED PETITION TO ACCEPT AN UNINTENTIONALLY
DELAYED CLAIM FOR THE BENEFIT OF A PRIOR-FILED APPLICATION
37 CFR §1.78(a)(6)**

Mail Stop DAC
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants resubmit their petition under 37 CFR §1.78(a)(6) to accept an unintentionally delayed claim for the benefit of a prior-filed application. As explained in the attached copy of the Decision on Petition, the petition was denied for presenting an amendment in an improper format. Specifically, the amendment was embedded in the petition document and the amendment included an improper incorporation by reference. To address these issues, the petition is resubmitted with a separate amendment, which does not include the offending incorporation by reference.

Applicants hereby petition for the acceptance of an unintentionally delayed reference to a claim for priority under 35 USC §119(e). The entire delay between the date the reference was due under 37 CFR §1.78(a)(5)(ii) and the date of filing this petition was unintentional.

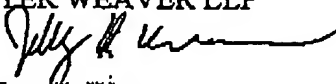
RECEIVED
CENTRAL FAX CENTER

APR 06 2007

Fees:

- ☒ In the original petition, which was denied, Check No. 12155 in the amount of \$1370.00 was enclosed for the petition fee (37 C.F.R. 1.17(t)).
- ☒ The Commissioner is authorized to charge any fees beyond the amount enclosed which may be required, or to credit any overpayment, to Deposit Account No. 500388 (Order No. NOVLP075).

Respectfully submitted,
BEYER WEAVER LLP


Jeffrey K. Weaver
Registration No. 31,314

P.O. Box 70250
Oakland, CA 94612-0250

RECEIVED
CENTRAL FAX CENTER

APR 06 2007



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEYER WEAVER LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

BEYER WEAVER LLP
ATTY: <u>JKW</u> ASSOC: <u>DSB</u>
ACTION <u>Req</u>
<u>Reconsideration</u>
DUE DATES
<u>5/19/07</u>
DOCKETED <u>3/22</u> BY: <u>a</u>
DOCKET NO.: <u>NOVLP075</u>

COPY MAILED

MAR 19 2007

In re Application of
Tipton et al.
Application No. 10/672,311
Filed: September 26, 2003
Attorney Docket No. NOVLP075/NVLS-
000820

OFFICE OF PETITIONS

:
:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 10, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

This pending nonprovisional application was filed on September 26, 2003, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/469,433 which was filed on May 9, 2003 and for which priority is claimed.

The amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that

Application No. 10/672,311

Page 2

each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Further, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(6) and either an Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) deleting the incorporation by reference statement, are required.

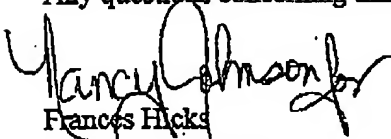
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Charlema Grant at (571) 272-3215.


Frances Hicks
Petitions Examiner
Office of Petitions